

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re Application of: John BORDER et al. | |
| Application No.: 09/996,445 | Group Art Unit: 2153 |
| Filed: November 28, 2001 | Examiner: Strange, A. |
| Attorney Docket: PD-201191 | |
| Client Docket: 10792_1065 | |

For: SYSTEM AND METHOD FOR READING AHEAD OF CONTENT

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully request a pre-appeal brief review be made of the present application for at the least the following clear errors.

I. EXECUTIVE SUMMARY

In order to reduce user response time associated with web browsing, the present invention provides for an upstream proxy server for forwarding requested URL content, along with information about an object(s) embedded in the URL content, to a downstream proxy server and for parsing the URL content to obtain the embedded object prior to receiving a corresponding embedded object request message initiated by the web browser (Specification-paragraph [12]). The actual forwarding of the requested content may be based on predetermined

criteria relating to the object. Such predetermined criteria may include, *inter alia*, a “time-to-live of the object” and “the object being marked as uncacheable.” (Specification, paragraph [41]).

II. ISSUE

Whether claims 1, 8, 15, 22, and 35 are properly rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement?

Applicants respectfully contend that the rejection is not proper and should be withdrawn.

The Examiner contends that the claim feature, “forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable” is not enabled by the specification. In particular, the Examiner states that “[t]he specification states that objects that have a time to live are cacheable (§41, Lines 9-10). Since a cacheable object would never be marked “uncacheable”, there is no way to forward an object based on this criteria, since no object would ever satisfy the criteria” (Final Office Action of July 25, 2007-page 5).

Respectfully, the Examiner’s conclusion that the two recited criteria are incompatible is flawed because it is based on a faulty hypothesis. Specifically, the Examiner contends, “The specification states that objects that have a time to live are cacheable (§41, Lines 9-10).” This is incorrect. What the pertinent part of paragraph [41] does state is, “...and forward objects which have a short time to live since such objects, **while cacheable**, are less likely to still be fresh in the downstream server cache 115” [emphasis added]. Clearly, this language does not equate objects with a short time to live with **always** being cacheable. The objects may be cacheable or may not be cacheable. The language of paragraph [41] merely points out that while such objects may or may not be cacheable, even when they are cacheable, they are less likely to

still be fresh. Thus, the forwarding of short time-to-live objects is not always inconsistent with the forwarding of uncacheable objects, as the Examiner indicates.

Moreover, the use of the conjunctive “and” in the recitation of predetermined criteria including “time-to-live of the object **and** the object being marked as uncacheable...” does **not** require these two recited criteria to temporally co-exist as criteria for forwarding an object since the recitation of the conjunction “and” in this case is merely a statement that these two criteria exist together on a list of predetermined criteria relating to the object. Applicants point to the fact that the claims recite predetermined criteria relating to the object “**including** time-to-live of the object and the object being marked as uncacheable” [emphasis added]. More predetermined criteria may also exist, in addition to these claimed criteria, but the present claims require only that **at least these two predetermined criteria are on the list of predetermined criteria used to forward the object**. The use of “and” does not require that **both** of the recited criteria actually be employed each and every time a forwarding decision is made (though they may both be employed in certain situations); only that at least these two criteria (time-to-live of the object and the object being marked as uncacheable) are on the list of predetermined criteria relating to the object to be used in forwarding the object.

To comply with the enablement clause of the first paragraph of 35 U.S.C. §112, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. *In Re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973); *In re Gay*, 50 CCPA 725, 309 F.2d 769, 135 USPQ 311 (1962). If the examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the appellant to come forward with evidence to rebut this challenge. *In re Doyle*, 482 F.2d 1385, 179 USPQ 227 (CCPA 1973); *In re Brown*,

477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 58 CCPA 1207, 442 F.2d 985, 169 USPQ 723 (1971). However, the burden was initially upon the examiner to establish a reasonable basis for questioning the adequacy of the disclosure. *In re Strahilevitz*, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982), *In re Angstadt*, 537 F.2d 498, 190 USPQ 214 (CCPA 1976); *In re Armbruster*, 512 F.2d 676, 185 USPQ 152 (CCPA 1975).

In the present case, the Examiner did not have a reasonable basis for questioning the adequacy of the disclosure because it was unreasonable to contend that “and” required both predetermined criteria of time-to-line of the object and the object being marked as uncacheable to be the basis of forwarding the object when the claims clearly recite these two criteria as being included on a list of predetermined criteria to be used for forwarding the object. While the claims do not explicitly recite a “list,” it is clear from the recitation of the predetermined criteria “**including**” such criteria that the recited criteria are part of a list.

To the extent the Appeal Panel may conclude that the Examiner did have a reasonable basis for challenging the sufficiency of disclosure, Applicants have rebutted the challenge by the explanation, *supra*, as to why the recited predetermined criteria form part of a list of acceptable predetermined criteria, and do not, necessarily, require the presence of the two recited predetermined criteria in order to forward the object, as apparently contended by the Examiner.


Since independent claim 35 does not include the recitation of “forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable,” the Examiner’s rejection of claims 35, 36, and 38, under 35 U.S.C. §112, first paragraph, based on non-existent claim language, is clearly improper and should be withdrawn.

III. CONCLUSION

For the foregoing reasons, the Appeal Brief Panel is respectfully requested to withdraw the rejection of the present application in light of these clear errors and allow the pending claims.

Respectfully Submitted,

11/21/07
Date


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